



DAC #3
#

In re application of: James J. Hickman, Douglas A. Kirkpatrick, and David A. Stenger
Serial No. 09/880,138
Filed: June 12, 2001
For: Biosensor For Use In Toxicity Assessment and Pharmacological Screening
Examiner: Unassigned

BOX MISSING PARTS Assistant Commissioner for Patents Washington, D. C. 20231	CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO BOX MISSING PARTS, ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C., 20231 ON 02/11/02 BY <u>Shirley Dow</u> SHIRLEY DOW February 11, 2002 Date of Signature
---	---

PETITION TO FILE DECLARATION FOR PATENT APPLICATION BY JOINT INVENTOR ON BEHALF OF NONSIGNING INVENTOR WHO REFUSES TO SIGN, AND STATEMENT OF FACTS IN SUPPORT THEREOF, UNDER 37 CFR § 1.47(a)

Science Applications International Corporation ("SAIC"), the assignee of Dr. James J. Hickman's and Douglas A. Kirkpatrick's entire right, interest, and title to the above invention and application, hereby petitions the United States Patent and Trademark Office to accept the Added Page To Declaration For Patent Application By Joint Inventor On Behalf Of Nonsigning Inventor Who Refuses To Sign or Cannot Be Reached (37 C.F.R. §1.47(a)) concurrently filed herewith.

It should be noted that the above-mentioned "Added Page to Declaration" filed herewith was executed by Dr. Hickman on behalf of both Drs. Kirkpatrick and Stenger. Since Dr. Hickman's execution of the "Added Page to Declaration," however, Dr. Kirkpatrick has executed the 37 CFR 1.63 Inventors' Declaration. Thus, although the "Added Page to Declaration" concurrently filed herewith was executed by Dr. Hickman on both Dr. Kirkpatrick's and Dr. Stenger's behalf, SAIC Petitions the Commissioner to accept Dr. Hickman's signature to the "Added Page to Declaration" only on behalf of Dr. Stenger -- the only remaining non-signing co-inventor.

It also should be noted that in the application as filed, the inventor Douglas A. Kirkpatrick was mis-designated as having "G" as his middle initial, when in fact it is "A." This has been corrected in the Correction to Filing Receipt filed concurrently herewith.

I. INTRODUCTION

In support of its Petition, SAIC provides the following Statement of Facts In Support Of Filing On Behalf Of Non-Signing Inventor Who Refuses to Sign.

II. STATEMENT OF FACTS

A. Application History

Patent application Serial No. 09/880,138, filed on June 12, 2001, was filed in connection with Applicant's Petition to Revive filed on that same date. SAIC has since filed a Renewed Petition to the Commissioner of Patents. If the petition is granted, the 09/880,138 application will be accepted as a continuation of, and claim priority from, Serial No. 09/513,720, filed on February 24, 2000, and which unintentionally went abandoned on June 12, 2000. In the event that the Petition is not granted, the 09/880,138 application will be deemed related to the 09/513,720, rather than a continuation thereof.

The 09/513,720 application was itself a continuation of, and claimed priority from, application Serial No. 09/372,568 filed on August 11, 1999, the prosecution of which was abandoned in favor of the 09/513,720 application. Patent application Serial No. 09/372,568, in turn, was a continuation of, and claimed priority from, application Serial No. 09/236,684, filed on January 25, 1999, the prosecution of which was abandoned in favor of the 09/372,568 application. Patent application Serial No. 09/236,684, in turn, was a continuation of, and claimed priority from, application Serial No. 09/109,481, filed on July 2, 1998, the prosecution of which was abandoned in favor of the 09/236,684 application. Patent application Serial No. 09/109,481, in turn, was a continuation of, and claimed priority from, application Serial No. 08/912,033, a non-provisional utility application, filed on August 15, 1997, the prosecution of which was abandoned in favor of the 09/109,481 application.

Furthermore, patent application Serial No. 08/912,033, in turn, claims the benefit of provisional application Serial No. 60/023,413, filed on August 16, 1996. The aforementioned applications, including the instant application, named these same three inventors.

B. SAIC's Proprietary Ownership Interest In This Application

SAIC is the assignee of two of the three inventors', Drs. Hickman and Kirpatrick, entire right, title, and interest in this application. Copies of the executed Assignments, wherein Drs. Hickman and Kirkpatrick each have assigned to SAIC their entire right, title, and interest to this application are attached hereto collectively as Exhibit A.

The other inventor, Dr. David Stenger, is an employee of the United States Government. (See Exhibit B: Statement Of Michael B. Lachuk at ¶ 3). Dr. Stenger's inventive contribution to the above-referenced application was made in the performance of a contract between SAIC and the United States Government. (See Exhibit B: Statement Of Michael B. Lachuk at ¶ 3). As a U.S. Government employee, Dr. Stenger had and still has an obligation to assign to the United States Government his ownership interest in any inventions conceived or first actually reduced to practice during the course of his performance on this Government contract. (See Exhibit B: Statement Of Michael B. Lachuk at ¶ 3). Pursuant to the standard intellectual property provisions of this Government contract, SAIC has the right to prosecute and pursue an application for a patent for this invention on behalf of itself and the United States Government, subject to the Government retaining an undivided co-ownership interest in any resulting letters patent. (See Exhibit B: Statement Of Michael B. Lachuk at ¶ 4).

Thus, it is clear from the foregoing that SAIC has a significant proprietary interest in this application.

C. SAIC's Diligent Effort Made To Secure Dr. David A. Stenger's Cooperation

In accordance with 37 CFR 1.47(a), this statement sets forth the facts that are relied upon to establish the diligent effort made by SAIC to secure Dr. David A. Stenger's cooperation in the execution of the requisite 37 CFR 1.63 Inventors' Declaration. Dr. Stenger is the non-signing inventor for the above-identified patent application and is the subject of this Petition.

In connection with this application and the various applications from which this application continues, at SAIC's direction, SAIC's outside counsel made numerous attempts to contact Dr. Stenger, to obtain his cooperation in the prosecution of said applications. As set forth in greater detail hereinbelow, Dr. Stenger has declined to cooperate and specifically refuses to execute the 37 CFR 1.63 Inventors' Declaration.

Dr. Stenger's last known address is: CODE 6910, Naval Research Laboratory, Washington, D.C. 20375.

The following summarizes the efforts made by SAIC's outside counsel, on behalf of SAIC, to obtain Dr. Stenger's cooperation in the execution of the requisite 37 CFR 1.63 Inventors' Declaration. After having undertaken efforts to locate Dr. Stenger, SAIC's outside counsel made telephone contact with Dr. Stenger. By letter dated November 9, 2001 addressed to Dr. Stenger via Certified Mail with return receipt, SAIC's outside counsel provided Dr. Stenger with a true and complete copy of the subject patent application, together with the requisite 37 CFR 1.63 Inventors' Declaration for his execution. (See Exhibit C: Letter to Dr. David A. Stenger dated November 9, 2001). On or about November 10, 2001, SAIC's outside counsel called Dr. Stenger by telephone, informing him that he should expect to receive the materials via Certified Mail. (See Exhibit D: Declaration of Mark B. Mizrahi at ¶ 3). Dr. Stenger stated that he would review the materials and would promptly respond. (See Exhibit D: Declaration of Mark B. Mizrahi at ¶ 3). Not having heard back from Dr. Stenger, on December 3, 2001, SAIC's counsel left a voicemail for Dr. Stenger inquiring into the status of the paperwork. (See Exhibit D: Declaration of Mark B. Mizrahi at ¶ 3). Dr. Stenger responded the following morning by stating that he had not received the November 9, 2001 letter and enclosures and asked that they be re-sent. (See Exhibit D: Declaration of Mark B. Mizrahi at ¶ 3).

On December 4, 2001, SAIC's counsel re-sent the November 9, 2001 letter and enclosures to Dr. Stenger, this time via Federal Express. (See Exhibit E: Re-sent Letter to Dr. David A. Stenger dated November 9, 2001). Via teleconference on December 20, 2001, Dr. Stenger informed SAIC's counsel that he declines to participate in the prosecution of the application. (See Exhibit C: Declaration of Mark B. Mizrahi at ¶ 4). Later that same day, Dr. Stenger confirmed this in writing and specifically declined to execute the 37 CFR 1.63 Inventors' Declaration. (See Exhibit F: E-mail exchange of December 20, 2001 between Dr. Stenger and Mr. Mizrahi).

The foregoing amply demonstrates SAIC's diligent effort to secure Dr. Stenger's cooperation in the prosecution of this application and Dr. Stenger's refusal to so cooperate, necessitating this Petition. The foregoing notwithstanding, it is evident from Section II(B) above that, under SAIC's contract with Dr. Stenger's employer, the U.S. Government, SAIC has the right to prosecute and pursue an application for a patent for this invention on behalf of itself and the United States Government, subject to the Government retaining an undivided co-ownership interest in any resulting letters patent.

III. CONCLUSION

Accordingly, pursuant to 37 CFR 1.47(a), it is respectfully requested that the Commissioner accept the accompanying Added Page To Declaration For Patent Application By Joint Inventor On Behalf Of Nonsigning Inventor Who Refuse To Sign Or Cannot Be Reached (37 C.F.R. §1.47(a)), in lieu of Dr. Stenger's executed Inventors' Declaration.

The Commissioner is authorized to charge the petition fee of \$130.00 under 37 C.F.R. §1.17(h) to Deposit Account 50-1597. A duplicate copy of this paper is enclosed.

Respectfully submitted,

By: Edward G. Poplawski
Edward G. Poplawski, Esq.
Registration No. 33,439

SIDLEY AUSTIN BROWN & WOOD LLP
555 West Fifth Street, Suite 4000
Los Angeles, California 90013-1010
Ofc: 213/896-6665
Fax: 213/896-6600

#4

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)
(Large Entity)

Docket No.
18805-81106

In Re Application Of: JAMES J. HICKMAN, DOUGLAS A. KIRKPATRICK AND DAVID A. STENGER

Serial No.
09/880, 138

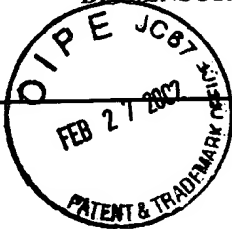
Filing Date
JUNE 12, 2001

Examiner
Unassigned

Group Art Unit
1636

Invention:

BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND PHARMACOLOGICAL SCREENING



TO THE ASSISTANT COMMISSIONER FOR PATENTS:

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the Office Action of August 9, 2001 above-identified application.
Date

The requested extension is as follows (check time period desired):

☐ One month ☐ Two months ☐ Three months ☒ Four months ☐ Five months

from: OCTOBER 9, 2001 until: (Saturday) FEBRUARY 9, 2002
Date Date

The fee for the extension of time is \$1,440 and is to be paid as follows:

- ☐ A check in the amount of the fee is enclosed.
☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 50-1597
A duplicate copy of this sheet is enclosed.
☒ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 50-1597
A duplicate copy of this sheet is enclosed.

Edward G. Poplawski
Signature

Dated: (Monday) 02/11/02

EDWARD G. POPLAWSKI, ESQ.
Reg. No. 33,439
SIDLEY AUSTIN BROWN & WOOD LLP
555 West Fifth Street, 42nd Floor
Los Angeles, CA 90013-1010
Tel: 213-896-6000
Fax: 213-896-6600

I certify that this document and fee is being deposited
February 11, 2002 with the U.S. Postal Service as
first class mail under 37 C.F.R. 1.8 and is addressed to the
Assistant Commissioner for Patents, Washington, D.C.
20231.

Shirley Dow

Signature of Person Mailing Correspondence

SHIRLEY DOW

Typed or Printed Name of Person Mailing Correspondence

03/06/2002 SMINASS1 00000012 501597 09880138

02 FC:118 1440.00 CH

CC: